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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Paper No. 21

Application Number: 08/425,766
Filing Date: April 19, 1995
Appellant(s): Greene, et al.

For Appellant

EXAMINER'S ANSWER

This is in response to appellant's brief on appeal filed September 7, 1999.

(1) *Real Party in Interest*

A statement identifying the real party in interest is contained in the brief.

(2) *Related Appeals and Interferences*

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

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(3) *Status of Claims*

The statement of the status of the claims contained in the brief is correct.

(4) *Status of Amendments After Final*

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) *Summary of Invention*

The summary of invention contained in the brief is deficient because it does not include language relating to the liquid filter element for capturing particulate matter in exhaust gasses, which is the focal point of the "recapture" debate. Applicants' reissue application attempts to broaden the claim language by withdrawing the liquid filter element from independent claims 1 and 15. Such withdrawal, examiner contends, violates the equitable Recapture Doctrine in the manner set forth in the Grounds of Rejection, below.

(6) *Issues*

The appellant's statement of the issues in the brief is correct.

(7) *Grouping of Claims*

The rejection of claims 1-20 stand or fall together because appellant's brief does not include a statement that this grouping of claims does not stand or fall together and reasons in support thereof. See 37 CFR 1.192(c)(7).

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(8) *Claims Appealed*

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) *Prior Art of Record*

No prior art is relied upon by the examiner in the rejection of the claims under appeal.

(10) *Grounds of Rejection*

The following ground(s) of rejection are applicable to the appealed claims:

Claims 1-20 are rejected under the equitable Recapture Doctrine as set forth in MPEP 1412.02. A synopsis of the Recapture Doctrine, especially in light of the recent C.A.F.C. decision in Hester Industries Inc. V. Stein Inc., 46 USPQ2d 1641 (1998) and how it applies to this application follows.

If a patentee tries to recapture what he/she previously surrendered in order to obtain allowance of original patent claims, that deliberate withdrawal or amendment cannot be said to involve the inadvertence or mistake contemplated by 35 USC 251 and is not an error of the kind which will justify the issuance of a reissue patent which included the matter withdrawn. The **recapture rule** bars a patentee from acquiring, through reissue, claims that are of the same scope or of broader scope than those claims that were canceled from the original application. In this regard, addition of narrowing limitations to a claim to overcome prior art is considered the full equivalent of cancellation of the claim and substitution of a narrower scope claim to overcome the prior art. See *Mentor Corp. V. Coloplast Inc.*, 27 USPQ2d 1521 (Fed. Cir. 1993).

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In Hester Industries Inc. V. Stein Inc., the C.A.F.C. extended the recapture doctrine to not only apply in cases where applicant has made amendments to claims in the original prosecution indicating critical subject matter, but also to apply to situations where applicant made arguments that subject matter included in the claims is critical. Id. at 1641. Such arguments, even if not accompanied by amendment, can give rise to a finding that the subject matter has been surrendered. The court in Hester held that the equitable principles serving as a foundation for estoppel notions apply equally to the context of recapture.

The applicability of Hester to the present case is further bolstered by decisions in Southwall Technologies Inc. v. Cardinal IG Co., 34 USPQ2d at 1682:

Estoppel extends beyond the basis of patentability, however. Clear assertions made during prosecution in support of patentability, whether or not actually required to secure allowance of the claim, may also create an estoppel.

and in Desper Products Inc. v. Qsound Labs Inc., 48 USPQ2d 1088:

The fact that the... reference could have been distinguished, standing alone, on different grounds is immaterial.... The public has a right to rely on the assertions made by a patent applicant to secure allowance of its claims. Post-hoc, litigation-inspired argument cannot be used to reclaim [abandoned] subject matter.

Applying these principles to the facts of this reissue application:

Applicant seeks to remove the following language from claim 1:

a filter for recapturing said particulate matter contained in said fired exhaust and for chemically treating said fire exhaust gases to reduce the quantity of CO, NO, and SO contained in said fired exhaust.

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Applicant also seeks to remove similar language from claim 15, the only difference being the particular compounds removed from the exhaust gases.

However, the removal of this language is barred by the equitable Recapture Doctrine when viewed in light of Hester. In the patent sought to be reissued, the patentee argued that this claim language sought to be removed rendered the claims patentable over the prior art cited and applied in the rejection of those claims.

In the patent file, paper No. 5, filed August 19, 1991, on page 4, the patentee argued that the prior art failed to mention a liquid filter arrangement as described and claimed by applicants, in that it did not mention a chemical treatment to reduce the quantity of CO, NO, SO, HCl or SO₂ as is required by applicant's claims. On page 5 of that paper, as Applicant has pointed to in his Appeal Brief filed September 7, 1999, the patentee's contention was that the references omitted **critical** features of Applicant's invention. The patentee continued on to discuss that one of the features not included in the references was the liquid filter element. Such an argument leads to the conclusion that the patentee believed that the liquid filter was indeed a critical feature of his invention. As discussed previously, Hester, with its underlying rationale grounded in notions of estoppel, bars the removal of any elements that were argued by the patentee as being critical to the invention. Clearly, as evidenced by the passage noted above and as Appellant has included in his Appeal Brief, the liquid filter was deemed critical to the invention originally filed.

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Furthermore, according to the decision in Southwall, estoppel extends beyond the basis of patentability. Applicants' assertions made during prosecution in support of patentability based on the liquid filter element, even if not actually required to secure allowance of the claim, also create an estoppel. According to Desper, the fact that the reference could have been distinguished, standing alone, on different grounds is immaterial. The public has a right to rely on the assertions made by a patent applicant to secure allowance of its claims. Applicants clearly asserted in support of patentability that the liquid filter was a critical feature of the claimed invention. It is immaterial whether or not the liquid filter was actually required to secure allowance of the claim.

Furthermore, in the patent file in the Appeal Brief filed 10/29/92, applicant also argued the liquid filter element being a novelty of the patented invention which distinguishes it from the prior art.

Thus, applicant is seeking to "recapture" subject matter which was surrendered during the original prosecution of the claims. This is improper and cannot be permitted.

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(11) Response to Argument

Appellant argues in the Appeal Brief filed September 7, 1999 that Applicants made no deliberate decisions in prosecuting the original application to surrender the liquid filter subject matter to overcome prior art and that, accordingly, the ruling of Hester Industries does not apply:

The Court, in Hester Industries, held that 'in a proper case, a surrender can occur through arguments alone.'... In determining that the case before it was 'a proper case', the Federal Circuit noted that Hester Industries was attempting to recapture the two claim limitations which it had indicated during prosecution were the primary basis for distinguishing the broadest claim over the prior art. The Court additionally noted that Hester Industries had claimed that the limitations sought to be removed via reissue were both critical and very material to patentability.... The present case is not a 'proper case' to hold that the Recapture Doctrine applies since Applicants never argued that the liquid filter element was the primary basis for overcoming prior art.

The Examiner is latching on to the word critical to make the case look the same as Hester Industries. However, Hester Industries never held that 'critical' was a magic word that automatically invoked the recapture rule. Although the Applicant used the words critical features, unlike Hester Industries, the applicants are arguing that the liquid filter, one of several limitations the applicants have argued were not found in the art made of record by the Examiner, was not needed for patentability.

However, as laid out above in the Grounds of Rejection, principles of estoppel do not require that Applicants argued that the liquid filter element was the primary basis for overcoming prior art. To reiterate, estoppel extends beyond the basis of patentability. Clear assertions made during prosecution in support of patentability, whether or not actually required to secure allowance of the claim, may also create an estoppel. *Southwall Technologies Inc. v Cardinal*

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IG Co., 34 USPQ2d at 1682. The fact that the reference could have been distinguished, standing alone, on different grounds is immaterial. Applicants clearly stated that the liquid filter was a "critical feature" of the invention which distinguished it from the prior art. The public has a right to rely on the assertions made by a patent applicant to secure allowance of its claims. Post-hoc, litigation-inspired argument cannot be used to reclaim abandoned subject matter. *Desper Products Inc. v. Qsound Labs Inc.*, 48 USPQ2d 1088.

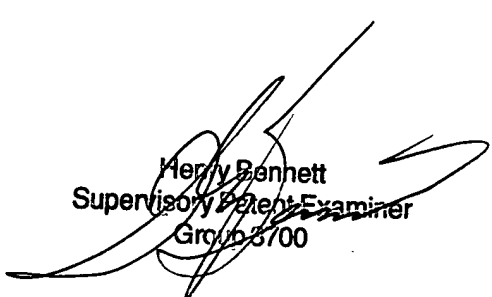
For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,



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Henry Bennett
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MN
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